



UNITED STATES PATENT AND TRADEMARK OFFICE

Tnta

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,185	12/05/2003	Roger Thomas	P-US-PR 1108	2379

7590 05/18/2005

Michael P. Leary
Group Patent Counsel
Black & Decker Corporation
701 E. Joppa Rd, Mail Stop TW199
Towson, MD 21286

EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
----------	--------------

3725

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,185	Applicant(s) THOMAS, ROGER	
	Examiner Shelley Self	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/3/04; 12/5/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: *12, 36, T, 80, 130, 132*.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "50" (pg. 5, line 10) and "52" (pg. 5, line 11) have both been used to designate recess.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor* and *airflow generator* (clm 1) and *the transparent window* (clms. 3, 5) must be shown or the feature(s) canceled from the claim(s). Further, claim 1 states a planer assembly and a debris collection container capable of being connected to the planer, i.e., a combination, this should be drawn, i.e. the planar and collection container should be illustrated in their combined structure. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

Art Unit: 3725

canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to under C.F.R. 1.71 as not containing a clear and concise description of the invention. For example page 6; lines 12 and 13 are particularly confusing. Line 10 of page 6 states reference to the third embodiment, yet lines 12 and 13 state "*...the second embodiment is exactly the same as the first embodiment except...*" there is no further description with regard to the third embodiment within the specification. Clarification is required.

The disclosure is also objected to because of the following informalities:

- Page 1, line 18 "shaving" should be —shavings—
- Page 4, lines 7 and 8, the phrase "*the workpiece upon which the planer is mounted on the cutting drum rotates*" is confusing.
- Page 4, line 21, "sidewaysly" is not understood

Page 9, line 25, "s126" is not clear,

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the specification nor the drawings provide support for *"the curved window acts as a deflector to turn the direction of travel of air or debris...within the connector through substantially ninety degrees."* This has not been described in detail to enable one having an ordinary level of skill in the art to make or use the claimed invention. Accordingly, the equivalents to of the prior art could not be ascertained, therefore no art has been applied.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 2, the connector has not been positively defined to

Art Unit: 3725

have a “whole”; furthermore, it not clear as to whether it is a *hole* meaning an opening or aperture or if “whole” represents an additional element. Clarification is required.

There are insufficient antecedent bases for the following:

“the whole” (clm. 2)

“the curved transparent window” (clm. 4, line 1)

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5 and claim 2 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellew (5,463,816) in view of Wixey et al. (6,601,621). Bellew discloses a planer assembly comprising a planer and a debris collection container capable of being connected to the planer, the planer comprising: a shoe defining an aperture (fig. 5); a body mounted on the shoe, the body defining a recess (fig. 5) and an exhaust aperture (figs. 3-5); a cutting drum (28) having blades (40) rotatably mounted within the recess of the body, a part of the periphery of the cutting drum projecting through the aperture (fig. 5) in the shoe; a motor (24) driveably connected to the cutting drum; an airflow generator (26) operable to create an airflow within the body for entraining debris created by the action of the cutting drum and to move the debris to the exhaust aperture through which the air and any entrained debris are

Art Unit: 3725

expelled from the body; and the debris collection container comprising: a receptacle/bag for storage of debris (col.4, lines 9-11) generated by the cutting drum; a connector connectable between the receptacle/bag and the exhaust aperture of the body of the planer and through which debris can pass from the body to the receptacle. Bellew does not disclose the connector includes a transparent window. Wixey teaches in a closely related art, a planer having a cylindrical cutter rotatably mounted wherein debris exhaust system disposes chips/shaving of wood that results from the planning operation (1280). Wixey further teaches the use of a fine mesh receptacle/bag (col. 27, lines 8-10, 16-24) that is connected to an exhaust aperture. Examiner notes that at least one polygonal section of the mesh receptacle serves as a "window", i.e., structure through which one can see thru. Therefore, because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace, Bellew's receptacle and connection, i.e. bag of which is connected to the exhaust aperture with a fine mesh bag as taught by Wixey so as to be able to see through the connection, i.e., upper most part of bag to see debris channeled from the exhaust aperture to the bag/receptacle as taught by Wixey.

With regard to claim 2, as best as can be understood, Bellew discloses the bag having an opening or hole/aperture which serves as a connector so as to connect the bag/receptacle with the planer exhaust aperture.

With regard to claim 3, Bellew discloses the bag/receptacle connection to be curved. Examiner notes the exhaust nozzle (56) to be curved (figs. 3 –5); therefore the bag/receptacle connection point about which the bag is connected to the exhaust (56) is also curve, i.e. not linear.

Art Unit: 3725

With regard to claim 5, Bellew discloses part spherical dome. Examiner notes that because it is the bag that is directly connected to the exhaust aperture, the open portion of the bag in contact with the aperture acting as a connector and the aperture (56) having a portion of a spherical dome shape (figs. 1-3), the portion of the receptacle/bag in contact with the aperture (56; col. 4, lines 9-11) is also a part spherical dome.


Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
May 11, 2005



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700